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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/306,761	05/07/99	DENEBERG	J 2685/5117

SAMUEL H DWORETSKY
AT&T CORP
P O BOX 4110
MIDDLETOWN NJ 07748-4801

WM02/1003

EXAMINER

LE, L

ART UNIT

PAPER NUMBER

2684

DATE MAILED:

10/03/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/306,761

Applicant(s)

DENEBERG ET AL.

Examiner

Lana Le

Art Unit

2684

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 May 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on 07 May 1999 is: a) ☐ approved b) ☒ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Tiedemann Jr. et al (US 5,629,975).

Regarding claim 1, Tiedemann et al discloses a method for registering a mobile communication device to a service comprising:

receiving via the first network, a request for a first service to be provided to the mobile communication device;

accessing a device capabilities database 50 using the received device identifier;

and when the mobile communication device is determined to be capable of receiving the requested service, setting up the requested service for the mobile communication device (col 8, lines 7-27).

Regarding claim 4, Tiedemann further discloses the device capabilities database stores information about whether the mobile unit is a multi-network phone and the mobile unit is determined to be capable of receiving the service when the device capabilities database indicates that the mobile unit is a multi-mode phone (col 9, lines 30-35).

2. Claims 6 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Fehnel (WO 97/34438).

Regarding claim 6, Fehnel discloses a method for registering a mobile communication device to a service comprising:

receiving a device attribute for the mobile communication device via a first communication network;

receiving via the first network a request for a first service to be provided to the mobile communication device;

accessing an attribute database using the received device attribute;

determining whether the mobile communication device is determined to be permitted to receive the requested service, setting up the requested service for the mobile communication device (page 19, line 19 – page 20, line 30).

Regarding claim 7, Fehnel discloses further the method of claim 6, the device attribute comprises an electronic serial number (ESN) associated with the device, the attribute database including an indication of whether a device having a particular ESN is a multi-network phone; and
the mobile communication device is permitted access to the requested service if there is an indication in the attribute database that the device is a multi-network phone (page 20, lines 3-9).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tiedemann et al (US 5,629,975) in view of Wild et al (US 5,862,480).

Regarding claim 2, Tiedemann didn't disclose further wherein when it is determined that the communication device is not capable of receiving the requested service, proposing an alternative service to the party that requested service wherein the alternative service is compatible with the mobile communication device. Wild et al discloses wherein when it is determined that the communication device is not capable of receiving the requested service, proposing an alternative service to the party that requested service wherein the alternative service is compatible with the mobile communication device (col 10, lines 8-50). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the alternative service to Tiedemann et al in order to provide for the mobile requester to choose another low service rate plan that's convenient for him/her.

2. Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tiedemann Jr. et al (US 5,629,975) in view of Frager (US 6,018,652).

Regarding claim 3, Tiedemann didn't disclose the method of claim 1 wherein the requested service comprises further a billing plan for communications using the mobile communication device. Frager discloses the method of claim 1 wherein the requested service comprises a billing plan for communications using the mobile communication device (col 2, lines 60-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the billing plan of Frager to Fehnel in order to determine the charges for different types of cellular phones and to show the reduced rate if the particular phone is eligible for the special service that was sought.

Regarding claim 5, Frager discloses further the method of claim 4 wherein the requested service comprises a billing plan for communications using the mobile communication device (col 2, lines 60-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the billing plan of Frager to Fehnel in order to determine the charges for different types of cellular phones and to show the reduced charging rate if the particular phone is eligible for the special pricing service that was requested.

3. Claims 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fehnel (WO 97/34438) in view of Frager (US 6,018,652).

Regarding claim 8, Fehnel didn't further disclose the device attribute includes a home location identifier to be associated with the mobile communication device;

the mobile communication unit is allowed access to the requested service if there is an indication in the attribute database that the home area of the mobile communication corresponds to a geographic area in which the service is receivable;

and the mobile communication device is permitted access to the requested service if there is an indication in the attribute database that the home location of the mobile communication device corresponds to a geographic area in which the service is receivable. Frager et al discloses the device attribute includes a home location identifier 16 to be associated with the mobile communication device (col 5, lines 15-21);

the mobile communication unit is allowed access to the requested service if there is an indication in the attribute database that the home area of the mobile communication corresponds to a geographic area in which the service is receivable; and the mobile communication device is permitted access to the requested service if there is an indication in the attribute database that the home location of the mobile communication device corresponds to a geographic area in which the service is receivable (col 3, lines 23-41). It would have been obvious to one of ordinary skill in the art to add the home location in order to provide the service only to those that belongs to the predefined area.

Regarding claim 10, Fehnel discloses a method for ascertaining whether to register a mobile communication device to a given service, the method comprising:

applying a device identifier to an equipment capabilities filter and registering the mobile communication device to the given service if the device identifier pass through the equipment capabilities filter.

Fehnel didn't disclose applying a home location identifier to a geographic eligibility filter; and registering the mobile communication device to the given service if the home location identifier pass through the geographic eligibility filter. Frager et al

discloses applying a home location identifier to a geographic eligibility filter; and registering the mobile communication device to the given service if the home location identifier pass through the geographic eligibility filter (col 5, lines 32-46). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the home location identifier to Fehnel in order to provide a special reduced rate for subscribers that are within a certain zone of the cellular service area.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lana Le whose telephone number is (703)308-5836. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Hunter can be reached on (703)308-6732. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-7314 for regular communications and (703)308-6306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

Lana Le

September 28, 2001


DANIEL HUNTER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

Art Unit: 2684

Restriction/Election

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-8, 10, drawn to registration, classified in class 455, subclass 435.
 - II. Claim 9, drawn to billing, classified in class 455, subclass 406.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as registration for fraud or identification purposes. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.
3. During a telephone interview with attorney Ahsan on 08/13 a provisional election was made with traverse to prosecute the invention of I, claims 1-8 and 10. Affirmation of this election must be made by applicant in replying to this Office action. Claim 9 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any

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amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Lana Le

September 27, 2001



DANIEL HUNTER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600